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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,764	10/31/2001	Michael B. Metzger	DT-4060	4324

7590

01/29/2004

SIDLEY AUSTIN BROWN & WOOD LLP
875 Third Avenue
New York, NY 10022

EXAMINER

MUROMOTO JR, ROBERT H

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 01/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,764

Applicant(s)

METZGER, MICHAEL B.

Examiner

Robert H Muromoto, Jr.

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because the recitation "This invention relates too...". Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities: the specification contains drawings that should be in a separate drawings section of the instant application. Additionally, multiple misspellings or typographical errors appear throughout the specification, such as the recitation "know" on page 6 which should be - - known- -, "in" on page 6, line 9; "angel" on page 7 should be - - angle - -; "fiction" on page 7 should be - - friction - -.

Also the margins of the disclosure are incorrect. The papers have writing that are obscured by the punch holes at the top of the page because the applicant has used the incorrect margins.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the multi-layer structure of the fabric/sock must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant has drawings throughout the specification that should be taken out of the specification to form a drawings section of the application that is appropriate to US Patent practice.

Claim Objections

Claim 5 is objected to because of the following informalities: the recitation "place" appears to be a typographical error in line 5. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pruitt '418.

Pruitt discloses an article of low friction footwear 10 that covers the lower leg, ankle, and foot of user. "FIG. 1 illustrates the components of an article of low friction footwear indicated generally at 10 that covers the lower leg, ankle, and foot of user 12. Footwear 10 comprises inner layer 14 of material, which fits closely around the foot of user 12. Footwear 10 further comprises friction isolation layer 16 that is disposed outwardly from inner layer 14. Friction isolation layer 16

may cover portions of inner layer 14 or the entirety of inner layer 14. As shown in FIG. 1, friction isolation layer 14 covers the upper portions of the ankle of user 12 and the lower calf of user 12. In the case where friction isolation layer 16 covers only a portion of inner layer 14 as shown in FIG. 1, friction isolation layer 16 may be held securely in place by retention strap 18 (means for securing layers to the third object) that passes underneath the foot of user 12 to secure friction isolation layer 16 in place.

(3) Finally, footwear 10 comprises outer layer 20 (third layer) of material that completely surrounds inner layer 14 (first layer) and friction isolation layer 16 (second layer). Outer layer 20 comes in contact with any shoe or boot worn by user 12. The movement of the shoe or boot would ordinarily cause a conventional sock to rub against the skin of the user 12. Due to the positioning of friction isolation layer 16 between inner layer 14 and outer layer 20, the movement of a shoe or boot around outer layer 20 causes outer layer 20 to move, but this movement of outer layer 20 is not translated to inner layer 14 that is disposed against the skin of user 12. In a similar way, friction isolation layer 16 may be placed directly against a person's skin.

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(4) Inner layer 14 (first layer) and outer layer 20 (third fabric layer) may comprise conventional fabrics used

to provide comfortable and durable socks, such as cotton, nylon, wool, or the like, and may also provide additional thermal insulation to the wearer.

Friction isolation layer 16 may comprise a wide variety of materials that provide a reduced or low-friction surface. For example, friction isolation layer 16 may comprise slick vinyl, satin cloth, mylar, plastic sheets, slick nylon, or any other material that will prevent the translation of movement of outer layer 20 to inner layer 14. Additionally, it may be desirable to form friction isolation layer 16 of a water proof or water resistant material.

Also, friction isolation layer 16 may be used with more than two layers of material. (col. 2, line 50-col. 3, line 20)"

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruitt '418.

Although *Pruit* teaches essentially all of the limitations of the instant invention, there is no specific teaching reciting polyester yarns or that the second layer be rotated 90 degrees with respect to the weave orientation of the first and second fabric layers.

However, *Pruit* clearly states that the fabric isolation layer 16 “may comprise a wide variety of materials that provide a reduced or low-friction surface. For example, friction isolation layer 16 may comprise slick vinyl, satin cloth, mylar, plastic sheets, slick nylon, or any other material that will prevent the translation of movement of outer layer 20 to inner layer 14. Additionally, it may be desirable to form friction isolation layer 16 of a water proof or water resistant material (col. 3, lines 12-20).” One of ordinary skill in the art would have been able to determine that polyester is a material that fills all of the listed requirements. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use a polyester yarn as a low friction material.

With respect to the limitation of rotating the second fabric's weave design 90 degrees, the examiner would like to point out that the conventional fabric teaching in *Pruit* implies a plain weave design. Plain weave designs are symmetrical in all directions. So if one rotated a fabric of plain weave design 90 degrees to another fabric of plain weave design the weave designs would still be in the same orientation as before the rotation. Since the applicant has not claimed any weave designs different from the plain weave it follows that the structure of claim 5 is the exact same structure of that in claim 1, especially since the applicant has claimed that each fabric have the “identical” top and bottom surface. Therefore it would have been obvious to one of

ordinary skill in the art to provide the low friction fabric of Pruitt with the second fabric rotated 90 degrees as the rotation itself causes no change in the physical structure of the multi-layered fabric.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various references have been cited that are pertinent to claimed invention as cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 703-306-5503. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Bhm
January 23, 2004


JOHN J. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700